(4)

No. 89-1909

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

FEIST PUBLICATIONS, INC.,
Petitioner,

v.

RURAL TELEPHONE SERVICE COMPANY, INC.,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

BRIEF OF THE INTERNATIONAL ASSOCIATION OF CROSS REFERENCE DIRECTORY PUBLISHERS AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER FEIST PUBLICATIONS, INC.

RICHARD D. GRAUER
Counsel of Record
DYKEMA GOSSETT
505 N. Woodward Ave.
Suite 3000
Bloomfield Hills, MI 48304
(313) 540-0864
Attorney for International Association of Cross Reference Directory Publishers

Of Counsel
KATHLEEN MCCREE LEWIS
FRANK K. ZINN
LAWRENCE J. GOFFNEY, JR.
DYKEMA GOSSETT
400 Renaissance Center
35th Floor
Detroit, Michigan 48243
(313) 568-6800

BOWNE OF DETROIT
610 W. CONGRESS - DETROIT, MICHIGAN 48226 - (313) 964-1330

QUESTIONS PRESENTED

1. Does the copyright in a telephone directory by the telephone company prevent access to that directory as a source of names and numbers to compile a competing directory, or does copyright protection extend only to the selection, coordination, or arrangement of those names and numbers?

2. Does the copyright in a factua. compilation prevent use of that compilation as a source of the compiled facts, or does copyright protection extend only to the expression of those facts, i.e., the selection, coordination or arrangement of those facts?

3. Where the act of copying from a copyrighted factual compilation is proven, must substantial similarity of the expression of those compiled facts, i.e., the selection, coordination and arrangement thereof, also be proven to establish infringement of the copyright?

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INTEREST OF THE *AMICUS CURIAE*[1]

The International Association of Cross Reference Directory Publishers ("IACRDP") is a trade association of eleven independent publishers of "cross-reference" directories. As explained below, cross-reference directories are not substitutes for, or competitive with, alphabetical telephone directories published by telephone companies such as Respondent Rural Telephone Service Company ("RTSC") and by independent directory publishers such as Petitioner Feist Publications ("Feist"). The interest of *amicus* IACRDP in the present case is heightened by a recent decision of the United States Court of Appeals for the Seventh

[1] The written consents of Petitioner and Respondent to the filing of this brief have been filed with the Clerk of the Court.

Circuit holding that a copyright in an alphabetical telephone directory was infringed by a cross-reference directory, notwithstanding substantial differences in the form of expression of the public domain facts used in the respective directories.[2]

Thus, the scope of protection to be afforded copyrights in compilations of fact, such as a telephone directory, is of vital concern to the members of *amicus* IACRDP. This issue is equally of concern to publishers of other types of directories who utilize copyrighted compilations of unprotectable public domain facts as a source of information to prepare non-competing works which fulfill needs which the prior copyrighted work cannot satisfy.

Whereas in the present case RTSC's copyrighted directory and Feist's accused directory are competing and functionally similar alphabetical directories, in *Haines* the copyrighted alphabetical directory of Illinois Bell was held to be infringed by Haines' non-competing and functionally dissimilar cross-reference directory. The same erroneous test for copyright infringement applied by the lower courts in the present case was applied in *Haines*[3] to restrict use of facts expressed in an entirely different arrangement. The broader factual context of *Haines* therefore highlights the significance of the legal and policy issuess concerning access to information which are raised by the present case, and demonstrates more starkly that the analysis of the lower courts is inconsistent with the copyright statute, its legislative history, precedents of this Court and public policy.

Approval by this Court of the infringement tests applied by the lower courts could be devastating to independent cross-reference directory publishers, as well as detrimental to the public interest. Even if the copyright owners elected to license these publishers rather than enforce their right to enjoin, the profit

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[2] *Illinois Bell Telephone Co. v. Haines and Company et al.* 905 F.2d. 1081 (7th Cir. 1990) (hereinafter Haines). Haines filed its petition for *certiorari* in this court on November 2, 1990.

[3] The District Court in *Haines* cited the District Court opinion in *Feist* six times.

margins in the cross-reference directory industry would not support license fees at the level demanded, for example, by Illinois Bell Telephone in *Haines*. The phone companies would have a monopoly, resulting in higher prices in selected larger markets and no cross-reference directory service at all in most smaller markets.

The disappearance of these directories from smaller communities now served by independent cross reference directory publishers is likely because of the historic pattern of limited participation by the public telephone companies in the cross-reference directory industry. The multi-state independent publishers can publish in the marginally profitable smaller communities because they maintain staffs large enough to handle the larger and more profitable jobs when required. The public telephone companies, however, which are confined to their own territories, are not likely to have staffs adequate for such tasks except in the larger metropolitan areas. The public benefit of access to such directories by emergency services, business and other public institutions in smaller communities would be lost.

Public telephone companies can legitimately claim no harm to their compilation efforts because they could, in proper circumstances, continue to enforce their rights against publishers of competing jointly bound white and yellow page directories. Such directories employ the alphabetical arrangement of the telephone companies' white pages, so that an infringement might be found if the overriding "substantial similarity" test (discussed below) were satisfied.

DESCRIPTION OF THE PRODUCTS OF THE *AMICUS CURIAE*

A. Cross-Reference Directories Employ An Entirely Different Form Of Expression Than That Found In Alphabetical Telephone Directories

To appreciate the extent and consequences of the erroneous infringement tests applied by the lower courts, it is useful to highlight the differences between the white pages section of a conventional alphabetically arranged telephone directory and a cross-reference directory.[4] Cross-reference directories do not contain an alphabetically arranged list of telephone subscribers. Instead, they contain two basic sections: a street address section and a telephone numerical section.

[4] *See also*, the District Court's opinion in the previously cited *Haines* case, 683 F. Supp. 1204, 1205-06 (N.D. Ill. 1988).

The street address section arranges the facts by *street address*. Street names are arranged alphabetically, and under each street the addresses are listed in numerical order, followed by the occupant's name and phone number. All addresses are zip coded. Additional information is often provided, such as community name and unofficial neighborhood designation, business identification, new listing identification and demographic information such as relative wealth rating for the Census Tract in which such address is located. A photocopied excerpt from a typical Haines cross-reference directory is shown below:

Addressakey

THE HAINES DIRECTORY

LILLIAN CT 60042
ISLAND LAKE

103	NISSEN C E	526-2343	9
105	SONNE ROBT A	526-6305	9
	SONNE ROBT A CHLD	526-9026	8
106	TUCKER WM	526-2492	3
107	GRANUM ERNEST H	526-5865	9
111	XXXX	00	
*	0 BUS 6 RES	0 NEW	

LILLIAN PL W 60002
ANTIOCH

22520	TURNER O W	395-1254	3
*	0 BUS 1 RES	0 NEW	

LILY W 60050 MC HENRY
LILYMOOR AREA

701	COFFMAN RANDALL	385-1112	0
702	NETTLES CHAS E	385-5005	7
704	XXXX	00	
*	0 BUS 3 RES	0 NEW	

LILY LN 60021
FOX RIVER GRV

503	HOVORKA CLARENCE C	639-5370	+4
505	RODERICK ROBT J	639-8055	+4
*	0 BUS 2 RES	2 NEW	

LIMERICK DR 60012 CONT

2010	WEIDNER MATHEW L	639-7143	6
2011	BINDI LOUIS G	639-0306	+4
2012	MEYER WM A	639-1975	+4
2013	LALOND ALLEN	639-4459	
2014	IVERSON BARBARA	639-5835	9
2015	LALOND ALEX A	639-2698	1
2016	MOORE TERRENCE	639-8129	3
2017	KOOE RUSSELL	639-1608	0
2018	XXXX	00	
2019	MCNAMARA PATK	639-8121	3
2020	XXXX	00	
2022	WILSON D	639-4169	
*	1 BUS 21 RES	3 NEW	

LINCOLN 60102
ALGONQUIN

308	XXXX	00	
309	CARDELLA P	658-9453	+4
	PAWLOWSKI STANLEY	658-7508	
310	XXXX	00	
315	MARRAH THOS W	658-6876	
	MARRAH THOS W	658-6876	7
321	TRIPLETT WM J JR	658-4191	0
326	GRESENS CHAS B	658-4387	8
327	MAY GLENN H	658-6108	8
333	HINKLE JAS M	658-4882	0
401	JUDD ROBT C	658-7102	5
403	BEU MARIAN J	658-7442	+4
407	JANSSEN CHAS R	658-2310	0
414	OAKES EVERETTE	658-8244	
420	BOHSE M	658-6807	7
426	ANDERSON NELS E	658-7128	2
427	PETTERSON H	658-4165	5
433	KASPER C	658-3621	2

The telephone numerical section arranges the facts by *phone number*, in numerical order, followed by the subscriber's name. Some directories also include address listings, business identification listings and identification of which listings are new or changed. Another sample from a Haines cross-reference directory shows this section:

Telokey

THE HAINES CROSS DIRECTORY

3835	KINGDOM HLL JEHOVAH	225 DILGER AV WAUK
3838	STAIKOLAS SERBN CH	228 COUNTY N WAUKE
9848•	REHOBOTH CH	1001 INDIANA WAUKEGAN
9851	OGDEN J D JR	1115 RIDGELAND AV WAUKEG
	OGDEN J D JR	1115 RIDGELAND AV WAUKEG
9853•	GETHSEMANE CH GOD	631 MC ALISTER AV W
9860•	TOP O THE MORN	438 FRANKLIN WAUKEGAN
9876	BUTTERNUT BREAD DIV	2909 GRAND AV WAU
9880	WHITEHEAD BARBER SH	712 GENESEE S WAU
9887	MCDONALDS RESTRNT	3249 BELVIDERE RD W
9892•	REYES GROCERY STR	29 GENESEE S WAUKEG

(815)338-0010

0010	ROUSEY GLENN	220 DONOVAN AV E WOODST
0011	MAST DONALD C	523 CALHOUN E WOODSTOCK
0012	FABOS S M	342 [illegible] WOODSTOCK
0014	HEER M C	322 SEMINARY AV N WOODS
0017	WALSH JAS M	918 BLAKELY WOODSTOCK
0018	JARNECKE NORMAN L	1721 SEMINARY AV N W
0019	LEMBKE LARRY	476 JACKSON W WOODSTOCK
0020	NEUCHELLER B B MD	844 OAK WOODSTOCK
0021	GITLIN H JOS ATTY	111 DEAN WOODSTOCK
0022	CAPLAN MICHAEL S	1308 ISLAND CT WOODSTO
0023	WOODSTOCK NEWS AGCY	142 WASHINGTON
0024	TAYLOR GEO B	1217 BLAKELY WOODSTOCK
0025	WESKERNA EDW A	908 SOUTH E WOODSTOCK
0026	THOMAS MOBIL	315 MADISON N WOODSTOCK
0027	DEBOER ARTHUR MD	4101 DEAN STREET RD W
0029	CONNOR WM M	14810 DOGWOOD LN WOODST
0029	THORNE H K	709 DEAN WOODSTOCK
0030	GLUTH FRANK	2202 STEIG WOODSTOCK
0032•	FULLERTON ROBT G	1212 OAKVIEW TER WOOD
0035	NICHOLS LUCYLLE	111 TERRY CT WOODSTOCK
0181	STANGER EVANS MRS	918 TAPPAN WOODSTOC
0182	ANDREW RUSSELL F	13301 HICKORY LN WOOD
0184	SHAW RAYMOND C REV	1012 HICKORY RD W
0185	SCHNEIDERMAN LEROY	176 TERRY CT WOODS
0186	JOHNSON RAYMOND MRS	515 JUDD W WOODS
0187	FEDERAL LAND BANK	2032 SEMINARY AV N W
0188	WAYNES CTY LANES	109 CHURCH WOODSTOC
0189	MCBROOM F L	351 MADISON S WOODSTOC
0190•	DONAHUE JOHN J	10509 COUNTRY CLUB RD W
0191	PHILIPP JACOB	428 LAWNDALE AV WOODSTO
0192	LEE JAS H	12901 PLEASANT VLY RD WOC
	NORTHERN IL ALARM CO	12901 PLEASANT VLY
0194	VANDEVEER MICHAEL	8412 CONCORD DR WOO
0195	NELSON RUSSELL V	731 WHEELER WOODSTOC
0196	BAYTON ROBT E	1250 MITCHELL WOODSTOCK
0197	BOWE FRANKLIN S	1213 CLAY WOODSTOCK
0198	JOHNSON RONALD A	1427 SEMINARY AV N WO
0199	LUMPP EDW T	14518 PERKINS RD WOODSTOC
0200	KNEBUSCH WM L	611 W MAIN AV W WOODST
0202•	SKITTYS BODY SHOP	225 CALHOUN E WOODS
0203	CANNIZZARO E	115 DONOVAN AV E WOODST
0205	NASLUND WM C	631 JEFFERSON S WOODSTO
0207	LISTON DON J	535 PLEASANT WOODSTOCK
0210	WOODSTOCK OPTICL SV	666 JACKSON W WO
0211	SCULLY E J	10612 COUNTRY CLUB RD WOO
0212	ANDERSON GLENN E	418 PLEASANT WOODSTO
0213	FOAT DONALD	51 RAYCRAFT RD WOODSTO
0214•	PHILLIPS BRADLEY	331 HAYWARD S WOODSTO
0215•	KRUMPEN MILTON	402 JACKSON W WOODSTOC
0216	KLEMME ROGER	542 PLEASANT WOODSTOCK
	KLEMMES FLOOR SERV	542 PLEASANT WOODS
0217•	VANDEVEER L	8412 CONCORD DR WOODSTOC
0218	LUSK GEO E	406 FLEMING RD N WOODST
0221	BAKER PETERSON CO	DONOVAN AV W WOOD
0222	SCHMIDT PRNTG	130 WASHINGTON WOODSTO

Thus, cross-reference directories do not and cannot compete with alphabetical telephone directories. An alphabetical directory cannot be used to learn the name of a person or business located at a known address, or to whom a known phone number belongs. Conversely, a cross-reference directory cannot be used to obtain an address or phone number of a known individual or business.

B. Cross-Reference Directories Perform Unique Functions

Cross-reference directories have been published for more than seventy years.[5] At least 600 such directories are published annually by independent cross-reference directory publishers. Virtually every community with more than 20,000 businesses and households is served by these directories. The eleven IACRDP members publish directories serving forty-eight states, the District of Columbia, and three Canadian provinces.

Cross-reference directories contain no advertising. Distribution is too limited, both in quantity and nature of directory purchasers, to offer any potential for advertising revenue. The costs of compilation and publication are borne by directory purchasers, typically $50 to $150 except for very large metropolitan areas where a multi-volume set may cost several hundred dollars.

Cross-reference directories are widely used by government, business and public service organizations. Major users include law enforcement agencies, fire departments, medical and emergency services, political campaigns, voter registration offices, religious organizations, charities, the media, businesses, attorneys, schools, salespeople, public utilities, banks, collection agencies and even Bell System telephone companies.

Smaller community emergency services must rely on their copy of a cross-reference directory to supplement the often incomplete location description supplied by the emergency caller.

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[5] The facts appearing in the following six paragraphs were taken from the trial record of the *Haines* case, 683 F.Supp. 1204.

For small local businesses (e.g., realtors and household services), cross-reference directories provide an inexpensive way to target an audience in their own territory. Envelopes or flyers can be addressed by a secretary, or occupants called directly on the telephone, without the expense of an advertising agency-prepared direct mail campaign. The consumer also benefits because the more efficiently targeted advertising costs less and results in lower prices of the goods or services advertised.

C. The Compilation Of A Cross-Reference Directory Involves Several Sources

A cross-reference directory is not merely the result of copying and rearranging the data from an alphabetical telephone directory. Many additional sources are required to produce a cross-reference directory. All street addresses, zip codes, business and residential notations, community names, neighborhood names, apartment notations, street corner designations, and length of occupation of an address are derived independently of any telephone directory.

Cross-reference directory publishers must and do use telephone directories as one of their research sources for their annual compilation process. There is no other source for names and telephone numbers. The only alternative to the use of alphabetical telephone directories would be a prohibitively expensive annual door-to-door canvass of the entire covered territory.

SUMMARY OF ARGUMENT

The Copyright Act authorizes copyrights for compilations of pre-existing facts only when they are "selected, coordinated or arranged in such a way that the resulting work as a whole constitutes an original work of authorship" (17 U.S.C. 101). The Act expressly precludes "any exclusive right in the pre-existing material" (17 U.S.C. 103b).

At issue here are copyrighted "white pages" telephone directories, wherein pre-existing facts are arranged as an alphabetical

list of telephone subscribers, followed by their respective addresses and telephone numbers. The individual facts are not part of a confidential customer list of the telephone company; they are in the public domain. The telephone companies are required by law to publish and distribute such facts to their customers.

Cross-reference directories, such as published by *amicus* IACRDP's members, arrange such facts in an entirely different way: (1) in numerical order by street address, and (2) in numerical order by telephone number. Thus, cross-reference directory publishers do not use the protectable *expression* of those facts found in the telephone companies' white pages. They create independent works using "pre-existing material," as authorized by the Copyright Act.

The Copyright Act, precedents of this Court and underlying public policy all require that copyrights in factual compilations such as alphabetical telephone directories be strictly confined to the minimally creative expression embodied in such alphabetical arrangement of the public domain facts, an expression not used in cross-reference directories.

The lower courts in both the present case and *Haines* erred in omitting from the test of copyright infringement the determination of substantial similarity between the *expression* of the compiled facts (*i.e.*, the selection, coordination and arrangement thereof) employed in the copyrighted and accused works. Where the similarity is only in the uncopyrightable facts, and not in the expression thereof, the similarity is not "substantial" and there is no infringement.

ARGUMENT

A. The Scope Of Copyright Protection In Factual Compilations Is Limited By Statute

The copyright law, like the patent law, finds its origin and purpose in the Constitutional grant to Congress of the power "to promote the Progress of Science and useful Arts, by securing for

limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries" (U.S. Constitution, Art. I, §8).

The 1976 Copyright Act provides copyright protection for "original works of authorship" (17 U.S.C. 102a), including compilations, which the Act defines in this way:

> A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are *selected, coordinated or arranged* in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. 101, emphasis added.

In addition to the requirement of originality, the Act contains two explicit restrictions on the scope of protection afforded by a copyright, the first general and the second specific to compilations:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. 102b.

* * *

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work, and does not imply any exclusive right in the pre-existing material. . .

17 U.S.C. 103b.

While compilations of fact are copyrightable (17 U.S.C. 101), the copyright does not extend to the facts disclosed. Only the expression of those facts is protected by the copyright (17 U.S.C. 102b, 103b). Where, as here, the compilation is a

telephone directory, the pre-existing material or data which the statute explicitly excludes from protection are the individual listings of name, address and telephone number. The telephone companies, which typically obtain the data from their phone service customers when they apply for such service, are required by law to publish such data in an alphabetical directory.[6] The expression employed in a telephone directory is minimal: the selection process is virtually non-existent, because all numbers which the customers wish to be published are listed; the coordination and arrangement is the age-old and indispensable alphabetical arrangement.

The intent of the scope-restricting provisions of the Copyright Act is found in the language of the Senate Judiciary Committee Report:

> Copyright does not preclude others from using the ideas or information revealed by the author's work. It pertains to the literary, musical, graphic or artistic form in which the author expressed his intellectual concepts.

S. Rep. No. 94-473, p. 54 (1975) and H.R. Rep. No. 94-1476, pp. 56-57.

This distinction between unprotectable facts and protectable form or expression has been succinctly summarized by this Court:

> [N]o author may copyright facts or ideas. §102. The copyright is limited to those aspects of the work —termed "expression"— that display the stamp of the author's originality.

Harper & Row, Publishers v. Nation Enterprises, 471 U.S. 531, 547 (1985).

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[6] *Rural Telephone Service Co. v. Feist Publications,* 737 F.Supp. 610, 612 (D. Kan. 1990), adjudicating Feist's antitrust counterclaim in the principal case; *Haines,* 683 F.Supp. at 1205.

The Court stated the corollary principle, i.e., the subsequent user's *right to copy facts,* this way:

> Yet copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original — for example, quotations borrowed under the rubric of fair use from other copyrighted works, *facts or materials in the public domain* — as long as such use does not unfairly appropriate the author's original contributions.

Id. at 548 (emphasis added).

Similarly, a subsequent author has "an unfettered right to use any factual information" revealed in a work. *Id.* at 557. The copyright statute thus reconciles the interests of the prior author with those of subsequent authors and the public.

A cross-reference directory does not copy the telephone company's "original contribution" or the "expression" (as this Court put it in *Harper & Row*), or the "form" (as the Senate Report put it), or the "select[ion], coordinat[ion] or arrange[ment]" (as 17 U.S.C. 101 puts it).

The *Constitutional* right to copy uncopyrightable material (here, the facts within the telephone directory listings) was recently reiterated by this Court. Quoting from *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234, 237 (1964), the Court again held that a state may not "interfere with the Federal policy, found in Art. I, §8, cl. 8, of the Constitution and in the implementing Federal statutes, of allowing free access to copy whatever the Federal patent and copyright laws leave in the public domain." *Bonito Boats v. Thunder Craft Boats*, 109 S. Ct. 971, 979 (1989).

B. Sound Policy Reasons Support The Statutory Right To Copy Facts

Compelling policy reasons support this statutory license to copy and disseminate facts from copyrighted factual compilations. These reasons were well stated by Professor Gorman in a scholarly article (copies of which have been lodged with the Court) quoted with approval by this Court in *Harper & Row*, 471 U.S. at 563. He observed:

> Our law, as reflected in the terms of our copyright statutes and the language of our Courts, emphasizes the greater need to disseminate the contents of fact works in contrast to the contents of works of artistic or literary fancy.

Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Society 560, 561 (1982).

* * *

> [E]ven within the field of fact works, there are gradations as to the relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography. The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.

Id. at 563.

Gorman listed several reasons for affording greater freedom to copy factual information than fanciful or literary expression: (1) public interest in access to facts; (2) the expression or presentation of facts is often "dictated by and inseparable from the underlying information", with maps and directories being the best examples; (3) commentary on political, social and historical facts as fostered by First Amendment and fair use considerations; and (4) copyright is intended to protect literary or artistic expression, rather than the labor in discovering facts. *Id.* at 562.

Professor Gorman believes only limited scope is warranted for copyrights in directories:

> Because the underlying facts in the terse and exhaustive directory are in the public domain and because the expressive variations are so limited, the copyright should properly be a "thin" one (as with maps), lest the monopoly unduly

> hinder the dissemination of information in the public interest. *Even modest departures from the form of such a streamlined copyrighted compilation, or new contributions and revisions, should presumably warrant a finding of non-infringement.*

Id. at 571 (emphasis added).

Of similar mind is noted copyright authority Melville Nimmer, whose widely known treatise, Nimmer on Copyright, was cited fifteen times by this Court in the *Harper & Row* majority opinion. In his view, one who labors to bring to light obscure public domain material has performed a socially useful service, but that activity alone does not qualify as the "writing" of an "author" within the contemplation of the Constitution. He continues:

> The situation is quite different with respect to an original selection or arrangement of such public domain materials. Such selection or arrangement may in itself constitute an original contribution of authorship and should be protectable against appropriation under copyright principles. *However, the fact that an author has made such an original contribution is no basis for protecting the public domain materials per se if the original selection or arrangement is not copied.*

1 Nimmer on Copyright, §3.04, at p. 3-20.2 (1990) (emphasis added) (hereinafter Nimmer).[7]

As Professor Gorman observed, the presentation of facts is often "dictated by and inseparable from the underlying information" (29 J. Copyright Society at 562). To assure dissemination of the underlying facts in terse directories, he advocated a finding

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[7] The conclusion of the lower courts here and in *Haines* that the later author must conduct his own canvass to compile public domain facts is contrary to the modern trend of judicial decisions rejecting the idea that the first compiler's labor (his "sweat of the brow" or "industrious collection") is protectable by copyright. This subject has been well covered in the *amicus* brief filed herein by the Association of North American Publishers and the Directory Publishers Association, in whose discussion *amicus* IACRDP concurs.

of non-infringement for "even modest departures from the form of such a streamlined copyrighted compilation." This approach has been followed by the Courts:

> Factual works are different. Subsequent authors wishing to express the ideas contained in a factual work often can choose from only a narrow range of expression . . . Therefore, similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed.

Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 488 (9th Cir. 1984), *cert. denied*, 469 U.S. 1037 (1984).

Accord, Sid & Marty Krofft Television Productions v. McDonald's Corp., 562 F.2d 1157, 1168 (9th Cir. 1977) ("The idea and expression will coincide when the expression provides nothing new or additional over the idea."); *Morrissey v. Proctor & Gamble*, 379 F.2d 675, 678-79 (1st Cir. 1967) (protection "could exhaust all possibilities of future use of the substance"); *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co*, 513 F.2d 1183, 1188 (2d Cir. 1975) (protection on game rule book would impermissibly extend protection to the public domain game).

Cross-reference directories do not use the alphabetical form of expression employed in alphabetical telephone directories. They use only the bare-bone public domain facts, which are neither owned by the telephone companies nor protected by their directory copyrights. There is no other way to convey such facts except by repeating them, which cross-reference directories do in an entirely different arrangement and expression. Under the statute and the precedents, these acts do not constitute copyright infringement.

Citing the information/form dichotomy (or "idea/expression" as it is more frequently described) expressed in the Con-

gressional Reports (quoted at p. 11, *supra*), Justice Brennan concluded that:

> Congress made the affirmative choice that the copyright laws should apply in this way . . . This distinction [i.e., information/form] is at the essence of copyright . . . To insure the progress of arts and sciences and the integrity of First Amendment values, ideas and information must not be freighted with claims of proprietary right.

Harper & Row, 471 U.S. at 589-90 (dissenting).

Were this Court to conclude that the scope of protection of a copyrighted alphabetical telephone directory extends to an entirely different expression of the compiled facts, such as in a cross-reference directory, then these policies of promoting dissemination of information in the public interest, as intended by the Constitution and commented upon by Professor Gorman and Justice Brennan, would be severely inhibited. As has been described, cross-reference directories provide valuable and otherwise unavailable resources and benefits to government, business and the public. Such works neither compete with nor diminish the need for alphabetical telephone directories. They impair no legitimate interest of the copyright owner.

Because cross-reference directories are non-competing with and incomparable to alphabetical telephone directories, their creation should be encouraged in accordance with the Constitutional purpose of promoting progress.

> The world goes ahead because each of us builds on the work of our predecessors. "A dwarf standing on the shoulders of a giant can see farther than the giant himself."

Chafee, *Reflections on the Law of Copyright*, 45 Colum.L.Rev. 503, 511 (1945), quoted in *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 469, n. 28 (1984) (dissent).

C. The Lower Courts Applied An Erroneous And Incomplete Test For Infringement

In its analysis of the infringement issue, the District Court misunderstood and therefore misapplied the tests for copyright infringement. Its conclusion of infringement was affirmed by the Court of Appeals, without further analysis, "for substantially the reasons given by the District Court" (Feist's Petition for *Certiorari*, p. 4a).

The error was in the complete failure to apply the "substantial similarity" test, after finding that copying had occurred, to determine whether that which was copied was more than unprotectable facts or ideas. Initially, the District Court correctly stated how *the act* of copying may be proven:

> This element may be shown by either an admission of copying by the defendant, or by the indirect route of proving access to the directory and substantial similarity between the plaintiff's and defendant's works.

663 F.Supp. at 218.

Having found direct evidence of copying, both from an admission that RTSC's directory was used during the preparation of Feist's directory and from the presence in Feist's directory of four fictitious listings from the earlier RTSC work, the Court made this erroneous conclusion:

> Since we have direct evidence of copying in this case, we need not resort to an analysis of whether there was a substantial similarity between the two directories.

Ibid.

While the District Court was correct that the evidence made it unnecessary to apply the "substantial similarity" test to indirectly or circumstantially show *the act* of copying (*i.e.*, the absence of independent creation), it failed to realize that "substantial similarity" is also a test applied to determine whether the

nature and extent of the copying was an infringement.[8] Thus, as quoted above, the "substantial similarity" test *may* have to be applied to prove the act of copying, but it must *always* be applied at the next level of analysis, *i.e.*, to determine whether that which was copied was substantial enough in both quantity and substance to constitute copyright infringement. As the Court of Appeals for the Third Circuit has noted, "Substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement.... [D]issection and expert testimony in the former setting are proper but are irrelevant when the issue turns to *unlawful* appropriation." *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d. 904, 907 (3rd Cir. 1975), *cert. denied*, 423 U.S. 863 (1975) (emphasis added).

The failure to recognize that there *is* a next level of analysis to *every* infringement issue may have resulted from reliance on a streamlined two-part statement of the infringement test which appears in some cases and even in Nimmer's noted textbook series on copyright law. The two-part test comprises proof of (1) ownership of a copyright and (2) copying. 3 Nimmer §13.01, p. 13-4.[9]

But further reading reveals that Nimmer's treatise elaborated on the content of the copying element:

> Just as copying is an essential element of infringement, so substantial similarity between plaintiff's and defendant's works is an essential element of copying. Yet the determination of the extent of similarity which will constitute a substantial and hence infringing similarity presents one of

[8] The same error was made by both lower courts in *Haines*, where direct evidence of Haines' use of the IBT directory was available: "Establishing substantial similarity is necessary only when direct evidence of copying is unavailable." 905 F.2d at 1086.

[9] In fact, the Court in *Haines* cited a prior decision which, in stating the streamlined two-part test, relied on Nimmer's statement of the test. *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d. 607, 614 (7th Cir. 1982), *cert. denied*, 459 US 889 (1982).

> the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations.

3 Nimmer §13.03[A], p. 13-23.[10]

After describing two forms of similarity which satisfy the substantial similarity test[11], Nimmer cautions that even a finding of extended similarity does not complete the infringement analysis:

> To the extent that such similarity inheres in ideas, which are by definition unprotected, or in expression which is not proprietary to plaintiff, then an essential ingredient is lacking from plaintiff's prima facie case.

3 Nimmer §13.03[B][2], p. 13-52.

And, even more pertinent to the present compilation of facts:

> Because no copyright may exist in facts per se, the copyright in a book dealing with factual matters cannot be infringed by a work that copies such facts, but in a manner in which the particular verbal description of such facts is not copied [citing this Court's *Harper & Row* decision, *supra*].

Id. at p. 13-56.

* * *

> Even if the defendant has copied from the plaintiff's copyrighted work, if the only material thus copied are those elements of plaintiff's work which are not protectable, then the resulting copy will not constitute an infringement.

[10] Further reading of *Atari* shows that there, too, the Court recognized that copying which does not involve copying of the protected expression does not satisfy the substantial similarity element of the infringement test. 672 F.2d. at 614-15.

[11] Nimmer describes "comprehensive nonliteral similarity" (duplication of the fundamental essence or structure, but without word-for-word copying) and "fragmented literal similarity" (virtual word-for-word copying, but only of a fragment of the copyrighted work. 3 Nimmer §13.03 [A][1], p. 13-24; §13.03[A][2], p.13-41.

Id. at §8.01[D], p. 8-20.

* * *

> Similarity which is not "substantial", even if due to copying, is a noninfringing use of the plaintiff's "ideas".

Id. at p. 8-22.2.

Summarizing these criteria, *amicus* IACRDP respectfully suggests that, once ownership of a valid copyright is proven, infringement is established by proof of (1) the act of copying, either by direct evidence or by indirect evidence showing access to the copyrighted work plus substantial similarity of the copyrighted and accused works, and (2) substantial similarity with respect to the protectable expression of the underlying idea, facts or concept.

As applied to a copyrighted compilation of facts, the substantial similarity must be with respect to the expression of those facts, *i.e.*, the selection, coordination and arrangement of the facts. Where, as in *Haines*, the only similarity is in the facts, there is no "substantial" similarity and therefore no infringement.

CONCLUSION

Amicus IACRDP respectfully submits that the lower court judgment should be reversed and the scope of RTSC's copyright in its alphabetical directory should be narrowly confined to the particular expression of the facts employed therein. Its copyrightable aspect so defined, the information contained in such directory could be freely used as a source for names, addresses and phone numbers for incorporation in subsequent works which express those facts in a way which is not substantially similar because of differences in the selection, coordination or arrangement thereof.

Respectfully submitted,

RICHARD D. GRAUER
Counsel of Record
DYKEMA GOSSETT
505 N. Woodward Ave.
Suite 3000
Bloomfield Hills, MI 48304
(313) 540-0864
Attorney for International Association of Cross Reference Directory Publishers

Of Counsel
KATHLEEN MCCREE LEWIS
FRANK K. ZINN
LAWRENCE J. GOFFNEY, JR.
DYKEMA GOSSETT
400 Renaissance Center
35th Floor
Detroit, Michigan 48243
(313) 568-6800